

REMARKS

Claims 1-12 were presented. Claims 1-9 were made subject to a restriction requirement and were removed from consideration by the Examiner. Claims 1-9 are hereby cancelled without prejudice.

Claims 10 and 11 were rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 3,750,951 to Perl (hereinafter "Perl").

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Perl and a non-patent literature publication by Selders entitled "Electric Motors- Lubrication and Cleaning" that appeared in 1968 (hereinafter "Selders").

Independent claim 10 has been amended to more clearly recite the claimed invention, specifically by reordering the words originally present in the claim to read "A method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight" and deleting the phrase "the motor assembly configured to be used in food or medicine preparation activities subject to FDA oversight," that appeared later in the claim preamble. Support for the amendment is evident in claim 10 as originally filed, as well as throughout the Specification and drawings. No new matter is introduced by the amendment, and the scope of claim 10 is not narrowed in any way by the amendment.

Response to Rejection of Claims 10-11 under 35 U.S.C. §102(b)

Claims 10-11 were rejected under 35 U.S.C. §102(b) as being anticipated by Perl. The Office Action states that

Perl teaches an unsealed, open motor for a dishwasher which include the steps of inserting a washing fluid into the motor (inherently washing the motor), removing the fluid, and operating the motor after draining (inherently drying and protecting against failure) (col. 5, line 40).

Claim 10 as presently amended claims "A method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight." Applicants respectfully traverse the rejection.

Perl does not teach or suggest a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight. The Examiner plainly concedes that Perl teaches a motor for use in a dishwasher. The title of U.S. Patent No. 3,750,951 is "Heat System for Dishwasher." Perl describes the operation of the motor in its intended use as follows in the Abstract, and at column 1, lines 3-8:

A dishwasher in which fluid temperature is elevated by the direction of the fluid into heat transferral contact with the electric drive motor which supplies the conventional pumping power. In one embodiment of the invention a split phase motor is employed having windings enclosed in an oil bearing jacket and fluid is circulated both internally and about the periphery of the motor. Another embodiment includes the less conventional shaded pole type of induction motor as the power source and an encapsulated winding construction which provides insulation from but contact with the water for heat exchange.

This invention relates to dishwasher apparatus and more particularly to a novel type of dishwasher construction in which utilization is made of the conventional pump motor as a source of heat energy for elevating the temperature of the water for cleaning, sanitizing and drying.

The four objects of the invention recited by Perl at column 1, line 58, through column 2, line 10, all are related to heat energy transfer between the running motor and the dishwashing water.

The passage referred to by the Examiner as regards drying, at column 5, line 40, recites in the full sentence (column 5, lines 37-43):

While the elevation of temperature of wash water is of primary significance, it will be clear that when the dishwasher is evacuated of water a heating effect occurs upon the air therein if the motor 66 is energized, which

may assist in the drying cycle of operation, the impeller 81 in this instance serving to circulate air throughout the dishwasher enclosure.

It is clear from this sentence that the term “drying cycle of operation” refers to the dishes in the dishwasher, and it should be noted that any effort expended incidentally drying the motor (as the Examiner would like to suggest) results in the increase of the humidity of the circulating air and consequently a DIMINUTION of the drying effect on the dishes, which is CONTRARY to what the inventor is seeking to do. Perl is disinterested in the fact that the motor is also dried, assuming that it is in fact dried and that there are not residual quantities of water in the sump in which the motor is situated.

Nowhere in Perl is there any teaching or suggestion to use the described dishwasher or its motor in food or medicine preparation activities subject to FDA oversight, which is plainly a limitation of the pending claims. As is well known, dishwashers are used by placing therein dirty utensils, having biologically active waste food thereon and possibly other biologically active contaminants transferred by contact of the hands and mouths of the users of the dirty utensils thereon, and then introducing water and cleaning agents to remove the unwanted dirt. The cleaned utensils are generally not sterile, but merely cosmetically free of dirt, or “clean.” Sterilizing utensils generally requires use of an autoclave, rather than a dishwasher.

Washing the motor in the resulting unsanitary washing solution is not an activity that would qualify for approval under FDA guidelines, even if the motor were rinsed off at the end of the process. It is generally the case that apparatus, including motors used in food or medicine preparation activities subject to FDA oversight are cleaned in a separate step from the food or medicine preparation activities, and not during those activities. The Examiner has an obligation to support his assertion that the disclosure of Perl anticipates a “method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight,” because that is what claim 10 claims.

Furthermore, the suggestion by the Examiner that the motor is inherently cleaned is conclusory and is unsupported by facts. Without adducing any proof, the Examiner surmises that the motor is cleaned. It is the expectation of the undersigned, based on personal

experience, that after many dishwashing cycles performed according to the Perl invention, the motor of Perl will be significantly more dirty than when it was first put into use. According to the Examiner, it should be perfectly clean, because it inherently gets cleaned every time it is used. The Examiner does not account for the possibility that the motor in fact may retain within its housing material removed from the dirty dishes, and that regions of the interior of the motor may become permanently fouled with residue or particulate matter that is introduced with the dirty dishes. In using the Perl invention, the internal condition of the motor as regards cleanliness is irrelevant as long as the dishwasher provides cosmetically acceptable results.

By comparison, in a food or medicine preparation activity subject to FDA oversight, there are procedures to assure the cleanliness of equipment, and inspections to confirm that the procedures are performed. There are also FDA Good Manufacturing Practices (“GMP”, sometimes also referred to as current Good Manufacturing Practices, or cGMP) that are codified. See for example 21 Code of Federal Regulations Part 210 - CURRENT GOOD MANUFACTURING PRACTICE IN MANUFACTURING, PROCESSING, PACKING, OR HOLDING OF DRUGS and Part 211 - CURRENT GOOD MANUFACTURING PRACTICE FOR FINISHED PHARMACEUTICALS. It is unlikely that manufacturing equipment in which motors are submerged in the substances used to make drugs so as to warm those solutions would be acceptable under FDA guidelines. The Perl patent cannot be suggested to anticipate a motor used in FDA approved food or medicine manufacture.

Because Perl fails to teach or suggest a method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, Perl fails to anticipate independent claim 10 as presently amended. Applicants respectfully submit that independent claim 10 is patentable over Perl. Applicants further submit that claim 11 and claim 12 which depend from independent claim 10 are patentable as depending from an allowable base claim.

Response to Rejection of Claim 12 under 35 U.S.C. §103(a)

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Perl and a non-patent literature publication by Selders entitled “Electric Motors- Lubrication and Cleaning” that appeared in 1968.

The Office action states that

Perl teaches every aspect of the invention except periodically removing the motor to be cleaned. Selders teaches disassembly of the motorized device to provide a through cleaning, It is would have been obvious to a person of ordinary skill in the art at the time of the invention to remove the motor from the apparatus prior to cleaning to clean foreign matter from the motor, as taught by Selders. (emphasis added)

Claim 12 recites in relevant part, “removing the unsealed electric motor assembly from an apparatus to which it is mounted prior to performing the washing step.” Applicants respectfully traverse the rejection.

First, removal of a motor from an apparatus to which it is mounted is not the same as disassembly of a motor for cleaning. Claim 12 does not address DISASSEMBLY of the motor, but rather REMOVAL of the motor from the apparatus of which it is a part prior to the washing step. Nothing in claims 10 or 12 requires disassembly of the motor. It is irrelevant to claim 12 whether the motor is disassembled or not. In fact, there may be reasons to remove the motor prior to cleaning that have nothing to do with disassembly of the motor. One example could be motivated by a reason to avoid having a component of the cleaning medium from coming into contact with a portion of the apparatus other than the motor, and removal of the motor simply assures that absence of contact.

Selders teaches cleaning and lubricating electric motors, but never teaches or suggests anything about either removing a motor from some object with which it cooperates, or reinstalling the motor in such an object. If the Examiner is relying on Selders for the motivation for REMOVING the motor, that teaching does not appear at all in Selders.

At the section of the article headed "Cleaning," Selders discusses the cleaning and lubrication of general purpose electric motors.

In the section of the article headed "Lubrication," Selders teaches that

Proper lubrication of electric motors means the use of the right lubricant, in the right amount, and at the right time intervals. Manufacturer's directions should be followed closely. Common types of oiling systems used with sleeve-bearing motors are oil-wick, yarn-packed and ring-oiled. In general, a good grade of SAE 10 or 20 oil should be used for sleeve-bearings. Lighter or heavier oil may be used if temperatures are extremely high or low.

As is well known, the designation "SAE" as applied to oil or other lubricants refers to standards according to the Society of Automotive Engineers, and SAE 10 or SAE 20 oil is motor oil used, for example, in automobiles. SAE grade oil is completely unsuited to be used in motors used in food or medicine preparation activities subject to FDA oversight. SAE motor oil includes unacceptable hydrocarbons as the base material, and additionally comprises additives for such purposes as reducing breakdown of the hydrocarbons under heat, some or all of which are unacceptable chemically in food or medicine preparation activities.

Nothing in Selders teaches or suggests that the processes for cleaning or lubricating motors disclosed therein could be acceptable for use with motors used in any activity subject to FDA oversight.

1. The Examiner has provided no motivation, suggestion, or teaching to combine.

Neither Selders nor Perl provides any motivation, suggestion, or teaching to combine the teachings of the two documents. The Examiner has a burden of demonstrating that there exists a motivation, suggestion, or teaching to combine the teachings of two or more patents or other publications, which motivation, suggestion, or teaching must be found independent from the teachings of the application being examined. See *In re Werner Kotzab*, 217 F.3d 1365 (CAFC, 2000), in which an obviousness rejection supported by the BPAI was overturned by the CAFC.

The CAFC stated in *Kotzab* at pages 1369-70 (citations omitted):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not "evidence."

It appears that in the present instance, the Examiner has relied impermissibly on the disclosure of the present application to find motivation to combine Selders with Perl. Other than the teachings of the present application as to the benefit of removing the motor prior to the washing step, there is no such motivation in Selders, there is no such motivation in Perl, and neither reference suggests that it would be helpful to combine the teachings of the one with the other. Selders teaches nothing about dishwashers, and Perl is not concerned with cleaning the motor of his dishwasher, but rather maintaining the water temperature high while washing dishes.

2. Even if there were motivation, suggestion, or teaching to combine, which Applicants do not concede, neither Selders nor Perl teaches about motors used in food or medicine manufacture.

Neither Selders nor Perl teaches or suggests a method of washing a motor used in food or medicine preparation activities subject to FDA oversight.

Perl teaches a conventional dishwashing machine with a motor useful for heating the water used to wash the dishes.

Selders teaches cleaning and lubricating general purpose electric motors without describing any particular end use. If anything, given Mr. Selders' title as a State Extension Specialist with the Agricultural Engineering segment of the Cooperative Extension Service of West Virginia University, it is quite doubtful that his document was even intended to be directed to food or medicine manufacturing activities subject to FDA oversight.

Applicants respectfully submit that the combination of Perl with Selders is based on impermissible reliance on the Applicants' disclosure. Applicants submit that even if such combination could be shown to be somehow motivated, which motivation is not conceded, because neither Perl nor Selders teaches or suggests a motor assembly used in food or medicine manufacturing activities subject to FDA oversight, at least one of the limitations of claim 12 (by operation of 35 U.S.C. §112, 4th paragraph) is not taught by the combination. Applicants respectfully submit that claim 12 is patentable over Perl individually, over Selders individually, and over any combination of Perl and Selders.

Amendment and Response
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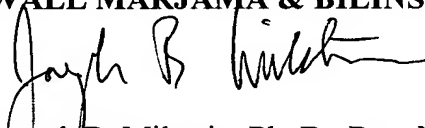
CONCLUSION

Applicants have amended claim 10 to more particularly claim the invention, without reducing the scope of coverage of claim 10. Applicants respectfully request that the application be reconsidered and that the rejections of claims 10-12 be withdrawn. Applicants submit that claims 10-12 are now in proper condition for allowance, and request the issuance of a Notice of Allowance at the Examiner's earliest convenience.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is requested to call Applicants' attorney at the phone number noted below.

Respectfully submitted,
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